

In re: Messina et al.  
Serial No.: 09/990,115  
Filed: November 21, 2001  
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### **REMARKS**

Claims 1-106 are pending. Claims 1-26 and 52-72 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,071,619 to De Winter ("De Winter") in view of U.S. Patent No. 6,335,379 to Leenslag et al. (Leenslag"). Applicants respectfully traverse the rejection of the claims for the reasons set forth below.

### **§103 Rejections Are Overcome**

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In an even more recent decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as recently stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining

whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

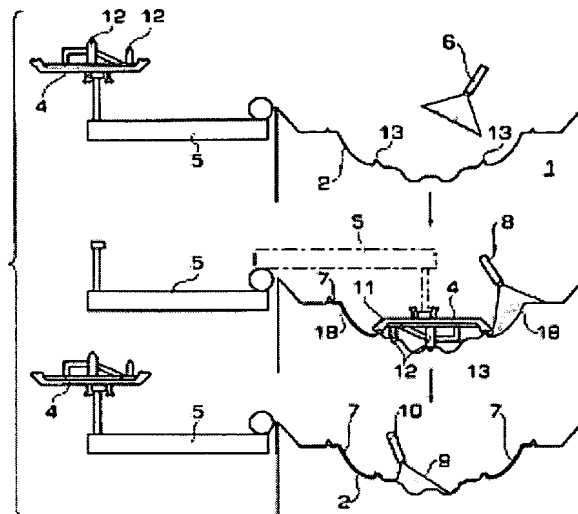
*In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Applicants respectfully submit that the pending claims are patentable over the primary reference, De Winter, because De Winter, alone or in combination with Leenslag, fails to disclose or suggest the recitations of the pending claims. For example, Applicants' independent Claim 1 recites a method of forming a sound attenuating laminate, comprising:

- ascertaining acoustic properties of an article on which the sound attenuating laminate is to be placed to identify areas wherein additional sound attenuation characteristics are necessary;
- forming a substrate in the shape of the article; and
- applying polyurethane on the substrate, wherein the polyurethane is applied substantially only in the identified areas wherein enhanced sound attenuation characteristics are required.

Independent Claims 16, 52 and 65 contain similar recitations.

De Winter describes a method for manufacturing an elastomeric skin comprising surface portions of at least two differently colored elastomeric materials, by spraying the elastomeric materials against a mold surface. A portion of a mold surface is shielded off by a mask and a layer of a first elastomeric material is sprayed onto the surface and onto the edge of the mask. The mask is removed and a second elastomeric material is sprayed onto the previously-masked portion of the mold surface. This is illustrated in Fig. 1 of De Winter, which is set forth below.



De Winter states that an object of his invention is to provide a method for manufacturing an elastomeric skin of at least two elastomeric materials which achieves an aesthetic visual parting line between the elastomeric materials. (De Winter, Col. 1, Lines 17-20). De Winter fails to teach or suggest ascertaining acoustic properties of an article on which a sound attenuating laminate is to be placed. De Winter fails to teach or suggest applying polyurethane only in the identified areas of the substrate wherein sound attenuation characteristics are required. Moreover, the Action concedes that De Winter is "silent about the sound attenuating properties." (Action, Page 3).

The secondary reference, Leenslag, describes flexible polyurethane foams and a process to prepare such foams. Flexible polyurethane foams according to Leenslag are prepared by reacting a polyisocyanate and a polyfunctional isocyanate-reactive polymer under foam forming conditions to prepare a rigid polyurethane foam and by crushing this rigid polyurethane foam. Leenslag fails to teach or suggest ascertaining acoustic properties of an article on which a sound attenuating laminate is to be placed and applying polyurethane only in the identified areas where sound attenuation characteristics are required.

The Action states that Leenslag describes polyurethane foams which are used in automotive seating, as well as for sound insulation and then merely concludes that it would have been obvious to one of skill in the art to modify De Winter with the flexible polyurethane foam of Leenslag "motivated with the expectation that the application of the

flexible polyurethane foam of Leenslag would improve the sound attenuation of the automotive applications regarding the claimed components of the claimed invention as noted." (Action, Page 4). Applicants respectfully submit that the Action's conclusion that it would be obvious to one skilled in the art to modify De Winter in view of Leenslag is not supported by clear and particular evidence, as required by the Federal Circuit. In fact, the Action fails to identify any passages within either De Winter or Leenslag that support this conclusion with clarity and/or particularity.

Specifically, the Action fails to identify where in Leenslag it is taught or suggested to ascertain acoustic properties of an article on which a sound attenuating laminate is to be placed and then applying polyurethane only in the identified areas where sound attenuation characteristics are required. The Action's conclusion appears to be based solely on the argument that, because Leenslag mentions that foams described therein can be used for sound insulation and automotive seating, the skilled artisan would be motivated to modify De Winter to mask areas of a mold surface corresponding to areas of an elastomeric skin not requiring sound attenuation. However, based on the fact that the mask described by De Winter is not utilized for the purpose of applying elastomeric material on the basis of sound attenuation characteristics, Applicants' respectfully submit that one skilled in the art would not be motivated to modify De Winter based on the statement that the Leenslag foams can be used for sound insulation and automotive seating.

Applicants respectfully submit that, in view of the above arguments, independent Claim 1, and all claims depending therefrom, are not rendered obvious by De Winter, alone or in combination with Leenslag. For similar reasons, independent Claims 16, 52 and 65, and all claims depending therefrom, are also not rendered obvious by De Winter, alone or in combination with Leenslag. Accordingly, Applicants respectfully request withdrawal of the present rejections under 35 U.S.C. §103.

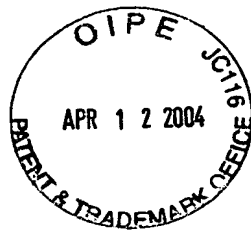
**Other Claims Are Independently Patentable**

Claim 8 is patentable by virtue of its dependence on patentable independent Claim 1 as described above. In addition, Claim 8 recites ***identifying areas of the article through which sound within a predetermined frequency range passes at an intensity level that exceeds a threshold intensity level***. Neither De Winter nor Leenslag, alone or in combination, teach or suggest ascertaining acoustic properties of an article that includes identifying areas of the article through which sound within a predetermined frequency range passes at an intensity level that exceeds a threshold intensity level. As such, Applicants respectfully submit that Claim 8 is independently patentable. For at least the same reason, Claim 23 is independently patentable.

Claim 14 is patentable by virtue of its dependence on patentable independent Claim 1 as described above. In addition, Claim 14 recites ***wherein the substrate has one or more recessed portions formed therein, and wherein applying polyurethane onto the substrate comprises applying polyurethane into the one or more recessed portions***. Neither De Winter nor Leenslag, alone or in combination, teach or suggest a substrate having one or more recessed portions formed therein, and wherein applying polyurethane onto the substrate comprises applying polyurethane into the one or more recessed portions. As such, Applicants respectfully submit that Claim 14 is independently patentable. For at least the same reason, Claim 63 is independently patentable.

Claim 15 is patentable by virtue of its dependence on patentable independent Claim 1 as described above. In addition, Claim 14 recites ***integrally forming a secondary article with the substrate, and wherein applying polyurethane onto the substrate comprises applying polyurethane into areas adjacent the secondary article***. Neither De Winter nor Leenslag, alone or in combination, teach or suggest forming a substrate in the shape of the article comprises integrally forming a secondary article with the substrate, and wherein applying polyurethane onto the substrate comprises applying polyurethane into areas adjacent the secondary article. As such, Applicants respectfully submit that Claim 15 is independently patentable. For at least the same reason, Claim 26 and 64 are independently patentable.

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In view of the above, it is respectfully submitted that this application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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